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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/765,108      | 03/27/1997  | MONTY KRIEGER        | MIT6620CIP          | 5650             |

7590 10/10/2002

PATREA L. PABST  
HOLLAND AND KNIGHT LLP  
ONE ATLANTIC CENTER  
1201 WEST PEACHTREE STREET, SUITE 2000  
ATLANTA, GA 30309-3400

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| EXAMINER |
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ULM, JOHN D

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1646

DATE MAILED: 10/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/765,108

Applicant(s)

Krieger et al.

Examiner

John Ulm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Jul 10, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-15, 19-22, and 44-50 is/are pending in the application.
- 4a) Of the above, claim(s) 44-50 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 and 15 is/are allowed.
- 6) ☒ Claim(s) 11-13 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 32 6) ☐ Other:

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- 1) Claims 11 to 15, 19 to 22 and 44 to 50 are pending in the instant application. Claims 11, 13 to 15, 21, 22, 44 and 48 to 50 have been amended as requested by Applicant in Paper Number 35, filed 10 July of 2002.
- 2) Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.
- 3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 4) Claims 44 to 50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 35. The traversal is on the ground(s) that the restriction was not earlier made. This is not found persuasive because 37 CFR 1.142(a), second sentence states: "[i]f the distinctness and independence of the invention be clear, such requirement will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner." Because Applicant elected to respond under 37 C.F.R. 1.111 to the office action containing the restriction requirement, that action has been treated by Applicant as a non-final action. Further, Applicant has failed to identify the supposed error in the requirement. Therefore, the requirement is still deemed proper and is made FINAL.
- 5) Claims 14 and 15 are allowable as written. Any properly dependant claim to a vector and/or host cell comprising an isolated nucleic acid of either of these claims, which is

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drafted in a manner which avoids any issues of clarity under 35 U.S.C. 112, second paragraph, would also be allowable.

6) Claims 11 to 13 and 19 to 22 stand rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is not enabling for the production of an isolated nucleic acid encoding a scavenger receptor protein lacking one of the amino acid sequences that are disclosed in SEQ ID NOs:4, 6 and 8 of the instant application for those reasons of record as applied to claims 9 to 13, 15, 17, 19 to 22 and 44 to 50 in section 5 of Paper Number 10. Applicant's traversal of this rejection essentially repeats those arguments of record which have been answered at length on the record.

7) Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant specification does not provide an adequate written description of a nucleic acid which encodes a human scavenger receptor protein such that an artisan could make and use that nucleic acid, for those reasons of record in section 4 of Paper Number 10. Applicant's traversal of this rejection also essentially repeats those arguments of record which have been answered at length on the record.

8) Claims 11 to 13 and 19 to 22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are indefinite in so far as they recite

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the term "scavenger receptor protein type BI" as a limitation for those reasons of record in section 8.1 of Paper Number 10. Applicant's response fails to identify that property of combination of properties which defines the limitation "scavenger receptor protein type BI"

9) Claims 11 to 13 and 19 to 22 are newly rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the metes and bounds of the limitation "under moderately stringent hybridization conditions at a temperature of approximately 25° C below the melting temperature of a perfectly based-paired double-stranded DNA" is undeterminable. First, the term "under moderately stringent hybridization conditions" is conditional and no specific set of defining conditions is provided by the claim or the specification. Second, because the melting temperature of a DNA molecule is dependant upon its the length and base pair composition, the limitation "the melting temperature of a perfectly based-paired double-stranded DNA" requires a reference to a specific "DNA", and none is given.

10) Claims 11, 19 and 20 stand rejected under 35 U.S.C. § 102(a) as being clearly anticipated by the Calvo et al. publication (J. Biol. Chem. 268(25):18929-18935, 05 Sept. 1993) for those reasons of record in section 9 of Paper Number 10. Applicant's traversal of this rejection essentially repeats and expounds upon those arguments of record which have been answered at length on the record.

11) Claims 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Calvo et al. publication (J. Biol. Chem. 268(25):18929-18935, 05 Sept. 1993) for those reasons of record in section 10 of Paper Number 10.

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12) Applicant's arguments filed 10 July of 2002 have been fully considered but they are not persuasive.

13) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

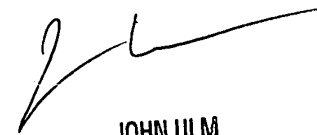
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM  
PRIMARY EXAMINER  
GROUP 1800